

REMARKS

Applicants have reviewed and considered the Final Office Action mailed on September 18, 2007. Claims 1-18 and 28-46 are currently pending in the application, of which claims 1-18 and 28-45 currently stand rejected. Applicants have added new claim 46. Applicants respectfully request reconsideration and allowance of claims 1-18 and 28-46 in view of the following remarks.

Addition of New Claim 46

New claim 46 recites a method for producing a synthetic cork compound. The feature of “adding toasted oak dust that does not consist of natural cork of approximately 1.0 weight percent ... to the mixture” is included in new claim 46. The addition of this feature is not a withdrawal of Applicant’s previous position that oak dust as defined in the specification, and as further supported by the Tiberia declaration, does not include natural cork. Rather, the addition of this feature to new claim 46 is meant to further clarify that the oak dust being claimed does not include natural cork. Applicants note, however, that the express negative limitation to natural cork applies only to the definition of oak dust and should not be construed as precluding the inclusion of natural cork as an ingredient separate from the oak dust. In other words, the negative limitation serves only to expressly limit the definition of oak dust.

No new matter is added by the addition of new claim 46. Support for the addition of new claim 46 can be found in the claims as originally filed and in the Applicant’s patent application in paragraphs 29-36.

Claim Rejections - 35 U.S.C. § 112

Claims 28-45 stand rejected under 35 U.S.C. § 112, first paragraph, for lack of enablement. Applicants respectfully traverse this rejection.

Applicants respectfully submit that Claims 28 and 37 are enabled by the originally-filed specification. "The test of enablement is whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation." *United States v. Telectronics, Inc*" 857 F.2d 778 (Fed. Cir. 1988). When considering whether a claim is enabled, a patent need not teach, and preferably omits, what is well known in the art. *In re Buchner*, 929 F.2d 660,661 (Fed. Cir. 1991). The originally-filed specification is enabling with respect to the limitations directed to oak dust not comprising or consisting of natural cork. The specification states that oak dust is used by the wine industry to enhance the flavor of wine. The Tiberia declaration clarifies that oak dust used by wineries does not include natural cork.

A person of ordinary skill in the art would be able to determine without undue experimentation that oak dust does not include natural cork. The test of enablement is not whether any experimentation is necessary, but whether, if experimentation is necessary, it is undue. *In re Angstadt*, 537 F.2d 498,504 (CCPA 1976). The application states in clear terms that the oak dust used in the compound of Applicants' claimed invention may be obtained from World Cooperage, a winery supply house. Without undue experimentation, a person of ordinary skill in the art would be able to contact World Cooperage or any other wine supply house and obtain oak dust. A visit to the website of World Cooperage at www.worldcooperage.com reveals that oak dust sold by the company (information contained at www.oaksolutionsgroup.com) does not include ground or powdered natural cork. Information from these web sites were included

with the Response to Office Action dated August 2, 2007. The information available from World Cooperage is consistent with the declaration of Tiberia, which clarifies that wineries do not add natural cork to wine. Since a person of ordinary skill in the art would be able to easily determine that oak dust, as contemplated by the originally-filed application, does not comprise or consist of natural cork, the specification is enabling of the limitations of claims 28 and 37.

Moreover, Applicants note that the Examiner has not met the burden imposed upon an Examiner to show non-enablement of a claim. In order to make a rejection, the Examiner has an initial burden to establish a reasonable basis to question the enablement provided for the claimed invention. *In re Wright*, 999 F.2d 1557, 1562 (Fed. Cir. 1993). The minimal requirement is for the Examiner to give reasons for the uncertainty of the enablement. *In re Bowen*, 492 F.2d 859, 862-63 (CCPA 1974). The language provided by the Examiner should "focus on those factors, reasons, and evidence that lead the examiner to conclude that the specification fails to teach how to make and use the claimed invention without undue experimentation, or that the scope of any enablement provided to one skilled in the art is not commensurate with the scope of protection sought by the claims." See MPEP § 2164.04. The Examiner in the present case has not met this burden. The Office Action does not address how a person of ordinary skill in the art would view the information provided in the specification about oak dust, nor the amount of "experimentation" that would be required for that person to understand that oak dust does not include natural cork. In fact, undue experimentation is not even mentioned in the Office Action. Because claims 28 and 37 are enabled by the originally-filed specification, and because the Examiner has not met the burden for showing enablement, Applicants respectfully request that the rejection of claims 28 and 37 and their respective dependant claims under 35 U.S.C. § 112, first paragraph be withdrawn.

Rebuttal of Examiner's Response

In response to the facts established above, the Examiner states as follows:

As regards the rejection of claims 28-45 under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling, applicant has failed to show where in the Specification the recitation "oak dust that does not consist of natural cork" finds support. (Office Action dated September 18, 2007, page 9).

As an initial matter, the Examiner's response does not address the burden imposed upon an Examiner to show non-enablement of a claim, and therefore fails to correct deficiencies that are present in the Examiner's original rejection under 35 U.S.C. 112, first paragraph. In particular, the Examiner response does not address, let alone meet, the initial burden of establishing a reasonable basis to question the enablement provided for the claimed invention.

In response to Applicants' use of the Tiberia declaration above, the Examiner states that:

Section 7, likewise, presents an unsupported statement of "(i)n addition to there being no benefit to the addition of natural cork to wine, the addition of natural cork as an ingredient of a wine could be detrimental since natural cork could introduce trichloroanisol (TCA) to the wine, causing the wine to develop a musty taste and smell." Primarily, the statement has no support in prior art or literature, but, moreover, the statement appears to contradict what is known in the wine arts. The use of cork stoppers, which come into direct contact with the contents of the bottle (the wine), since wine bottles are stored on their side, have been employed for centuries without the "detrimental (effect from) trichloroanisol (TCA)...., causing the wine to develop a musty taste and smell." Further, the instant claims are not drawn to a wine-additive as section 7 appears to indicate, but to a composition. (Office Action dated September 18, 2007, pages 10-11).

The Examiner's cited response incorrectly asserts that section 7 of the Tibernia declaration has "no support in prior art or literature." However, a simple internet search is sufficient to rebut the Examiner's incorrect assertion, as shown in the following excerpt:

Cork taint is a broad term referring to a set of undesirable smells or tastes found in a bottle of wine, especially spoilage that can only be detected after bottling, aging and opening. Though modern studies have shown that other factors can also be responsible for taint – including wooden barrels, storage conditions and the transportation of corks and wine – the cork is normally considered to be responsible, and a wine found to be tainted on opening is said to be "corked".

The chief cause of cork taint is the presence of **2,4,6-trichloroanisole (TCA)** in the wine. Corked wine containing TCA has a characteristic odor, variously described as resembling a moldy newspaper, wet dog, or damp basement. In almost all cases of corked wine the wine's native aromas are reduced significantly, and a very tainted wine is completely undrinkable (though harmless). While the human threshold for detecting TCA is measured in the single-digit parts per trillion, this can vary by several orders of magnitude depending on an individual's sensitivity. Detection is also complicated by the olfactory system's particularly quick habituation to TCA, making the smell less obvious on each subsequent sniff. (www.wikipedia.org, http://en.wikipedia.org/wiki/Cork_taint, March 16, 2008, bold emphasis in original, underlined emphasis added).

Despite such support, the Examiner nonetheless adds that "it is not clear to this Examiner why applicants insist that the use of oak dust in the composition claimed would present effects any more or less deleterious to the wine bottled with cork over the conventional cork stopper." (Office Action dated September 18, 2007, page 11). However, both the Applicants' patent application and the excerpt reproduced above support the benefits of minimizing the exposure of wine to natural cork, in this particular instance by using oak dust that does not comprise or consist of natural cork. Thus, the Tibernia declaration properly supports the proposition that oak dust used by wineries does not include natural cork. Thus, for the reasons above, the rejection of claims 28-45 under 35 U.S.C. 112, first paragraph has been overcome.

Claim Rejections - 35 U.S.C. § 103

The Examiner has maintained his rejections of Claims 1-18 under 35 U.S.C. 103(a) as obvious over Oka et al. (WO 03/020817), Meguriya I (U.S. Patent No. 5,981,610), or Meguriya II (U.S. Patent No. 6,506,331), and further in view of Des camps et al. (U.S. Patent No. 5,162,397), Strauss (U.S. Patent No. 4,031,059), and Snogren (U.S. Patent No. 3,296,153) all taken together.

References Do Not Teach or Suggest All of the Claimed Limitations

An applicant's claimed invention may be unpatentable under 35 U.S.C. § 103 only if it would have been "obvious" to a person of ordinary skill in the art to modify or combine the prior art in order to meet the claims, even if a single reference does not anticipate the claimed invention. *See*, 35 U.S.C.A. § 103(a) (West, WESTLAW through P.L. 110-36 approved 06-15-07); *Beckson Marine v. Nfm, Inc.*, 292 F.3d 718, 727 (Fed. Cir. 2002) (stating that "obviousness may render a claimed invention invalid where the record contains a suggestion or motivation to modify the prior art teaching to obtain the claimed invention," even if the prior art does not "reach expressly each limitation exactly"); *Hartness Int'l, Inc. v. Simplimatic Eng'g Co.*, 819 F.2d 1100, 1108 (Fed. Cir. 1987) ("the inquiry is not whether each element existed in the prior art, but whether the prior art made obvious the invention as a whole for which patentability is claimed"). "Obviousness" is a legal conclusion based on underlying findings of fact. *In re Peterson*, 315 F.3d 1325, 1328 (Fed. Cir. 2003). The underlying factual inquiry includes determining "the scope and content of the prior art;" ascertaining the "differences between the prior art and the claims at issue;" and resolving "the level of ordinary skill in the pertinent art." *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966); *In re Zurko*, 258 F.3d 1379, 1383-84 (Fed. Cir. 2001).

The Examiner, though, carries the initial burden of establishing a *prima facie* case of obviousness before rejecting a claimed invention under 35 U.S.C. § 103. *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998); *In re Alton*, 76 F.3d at 1175; *In re Oetiker*, 977 F.2d at 1445; *In re Wertheim*, 541 F.2d at 263 & 265; United States Patent & Trademark Office, MPEP §§ 2141, 2142, 706.020) (8th ed, rev. 5, 2006); *see also* 35 U.S.C.A. § 132. To establish *prima facie* obviousness of a claimed invention, the Examiner must demonstrate with substantial evidence that all the claim limitations are taught or suggested by the prior art. *See, e.g., In re Zurko*, 258

F.3d at 1384-85 (holding invention was not obviousness because prior art failed to teach single element); *In re Grassell*, 713 F.2d 731 (Fed, Cir, 1986) (finding that prior art was deficient in at least one element); accord MPEP § 2143.03 (citing *In re Royka*, 490 F.2d 981 (CCPA 1974)).

Independent claims 1 and 10 are allowable because none of the cited references teach or suggest all of the claimed limitations. Among other things, the references do not teach or suggest oak dust in any amount. As stated in Applicants' originally-filed specification, the inclusion of oak dust (toasted or untoasted), gives the resulting synthetic cork compound a mottled, speckled, or non-uniform appearance that closely resembles natural cork (see paragraph [0025]). This is important since one of the many possible uses of Applicants' compound is to provide a synthetic alternative to natural cork stoppers in wine bottles. The wine industry has in many cases been slow to adopt synthetic stoppers, and one commonly-stated reason for this is that synthetic stoppers do not closely resemble natural cork stoppers. Hence, the inclusion of oak dust as an ingredient greatly increases the likelihood of acceptance of Applicants' product as a synthetic substitute for natural cork wine stoppers. The effects of oak dust on Applicants' claimed invention are supported by the previously-submitted Affidavit of Jeanie Holmes.

Both Snogren and Strauss are cited in the Office Action for the teaching of ground cork or granulated cork in a silicone resin, and the Office Action asserts that these elements teach or suggest the oak dust component of Applicant's claimed invention. Applicants respectfully disagree with this assertion and submit that neither granulated cork nor ground cork teaches or suggests oak dust. Granulated and ground cork teaches or suggests particle sizes that are larger than dust, and neither reference mentions of "dust" or "cork dust."

If the Examiner wishes to rely upon an inherency argument to state that oak dust is taught or suggested by Snogren or Strauss, Applicants reminds the Examiner that a rationale or

evidence must be provided tending to show inherency. *See* MPEP 2112. The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531 (Fed. Cir. 1993). The Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art. *Ex parte Levy*, 17 U.S.P.Q.2d 1461 (Bd. Pat. App. & Inter. 1990). In the instant case, the teachings of Snogren and Strauss do not absolutely and necessarily teach a dust, let alone oak dust.

Failure to Provide Articulated Reasoning

The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results. *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1739 (2007). But most, if not all, inventions arise from a combination of old elements. *In re Kotzab*, 217 F.3d 1365, 1369 (Fed. Cir. 2000) (citing *In re Rouffet*, 149 F.3d at 1357). "Thus, every element of a claimed invention may often be found in the prior art" and the Examiner must consider the claimed invention as a whole. *Id.* at 1369-70; accord MPEP § 2141.02. "(I)dentification in the prior art of each individual par claimed is insufficient to defeat patentability of the whole claimed invention." *Kotzab*, 217 F.3d at 1370. The Examiner may not evaluate the invention "par by par," using the invention as a "roadmap to find its prior art components." *Princeton Biochemicals, Inc. v. Beckman Coulter, Inc.*, 411 F.3d 1332, 1337 (Fed. Cir. 2005). Hindsight reconstruction is impermissible. *Rouffet*, 149 F.3d at 1357-58; *In re Fitch*, 972 F.2d 1260, 1266 (Fed. Cir. 1992).

Moreover, an alleged reason for combining the teachings of the prior art must be supported by articulated reasoning with some "rational underpinning" to support the legal conclusion of obviousness. *See, KSR*, 127 S. Ct. at 1741 (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)). Broad conclusory statements of suggestion or motivation standing alone are not sufficient. *Id.*

The Office Action concedes that the primary references do not disclose oak dust in the amount claimed. The Office Action relies on Snogren and Strauss to fill this void. Thus, even assuming, *arguendo*, that Snogren and Strauss teach all that is alleged, the Examiner must nonetheless demonstrate with articulated reasoning that a person having ordinary skill in the art would have an apparent reason to combine the teachings of Oka, Meguriya I, or Meguriya II with the teachings of Snogren and Strauss such that the Applicants' claims as a whole are unpatentable. *See, KSR*, 127 S. Ct. at 1741. The Examiner has failed to satisfy this burden. *See* 35 U.S.C. § 132; MPEP §§ 2141, 2142, 706.020).

The references that the Examiner cites not only fail to teach or suggest all of the claimed limitations, as discussed above, but the Examiner merely provides broad conclusory statements regarding the apparent reason to combine the references in a manner that would render the claims obvious. The Office Action states that the "references represent art analogous in scope" such that "one having ordinary skill in the art would have a high level of expectation of success." The Examiner does not provide an articulated reasoning with rational underpinnings to explain how providing a silicone-based compound would motivate one to incorporate ground cork from an ablative compound to arrive at a material that resembles natural cork in both appearance and physical properties.

Consequently, the Examiner has failed to meet the burden of a *prima facie* case of obviousness under § 103, and the Applicants respectfully request that the rejection of claims 1-18 be withdrawn.

Rebuttal of Examiner's Response

In response to the facts established above, the Examiner states that:

Applicant contends "(g)ranulated and ground cork teaches and suggests particle sizes that are larger than dust, and neither references makes mention of 'dust' or 'cork dust'." It is pointed out to applicant that other terms, such as flake, particle, pellet, chip, particulate, pulverulent, powder, flour, granulate, micropowder, microparticle, nanoparticle, etc., also, are not referred to by either Strauss or Snogren since patentees do not have to disclose each and every possible term useful for a constituent. These terms are deemed to be synonymous. Applicant has failed to show by reference material or prior art that granulated or ground cork is larger in size. The assertion is not well-founded, either in science or reason. (Office Action dated September 18, 2007, page 13).

In the Examiner's response, the Examiner lists several terms, none of which appear in the cited references, that are allegedly synonymous and then concludes that Applicants' arguments are not "well-founded, either in science or reason." However, missing from the Examiner's analysis is any attempt to point out where in the cited references oak dust is mentioned. Further, the Examiner makes no attempt to show that oak dust is inherent in any of the cited references. Indeed, any such attempt must fail because the cited references fail to teach or suggest any dust at all, let alone oak dust, and instead disclose granulated or ground cork. Therefore, no *prima facie* obviousness rejection may be stated against claims 1-18.

Double Patenting Rejection

For the reasons stated above, claims 1-18 overcome the nonstatutory obviousness-type double patenting rejection over claims 1-16 and 21-41 of copending Application No. 10/685,052 in view of Snogren and Oka.

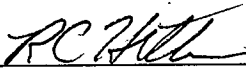
Applicants respectfully request that the double patenting rejection be withdrawn.

CONCLUSION

Applicants respectfully submit that the pending claims 1-18 and 28-46 are in condition for allowance and such a Notice is respectfully requested. The Examiner is invited to call the undersigned at the below-listed telephone number if, in the opinion of the Examiner, such a telephone conference would expedite or aid the prosecution and examination of this application.

Respectfully submitted,

DATE: 3/18/08



Robert C. Hilton
Reg. No. 47,649
Sonnenschein, Nath & Rosenthal
1717 Main Street
Suite 3400
Dallas, Texas 75201
TEL: 214-259-0907
FAX: 214-259-0910

ATTORNEYS FOR APPLICANTS